

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Hardison, Pamela)	Docket:	06-0320-PHA.RA
)		
Serial No.:	10/674,758)	Examiner:	Flick, Jason E
)		
Filed:	September 30, 2003)	Group Art Unit:	3763
)		

For: **DEVICE AND METHOD FOR SUPPORTING WOUND
DRAINAGE SYSTEMS**

Dated: March 7, 2011

Mail Stop – Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellant submits the following Appeal Brief pursuant to 37 C.F.R. §41.37 for consideration by the Board of Patent Appeals and Interferences. Additionally, Appellant submits the Appeal Brief fee pursuant to 37 C.F.R. §41.37(a)(2).

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Postal Service via EFS-
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Thomas R. Williamson III
(Name of Person Mailing)

/Thomas R. Williamson III/
(Signature of Person Mailing)

March 7, 2011
(Date)

I. Real Party In Interest

The real party in interest is the inventor and Appellant, Pamela Hardison.

II. Related Cases, Appeals, or Interferences

There are no related cases, appeals, interferences and/or patents known to the Appellant or Appellant's legal representative which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Applicant's claims 1-20 and 22, submitted April 6, 2010 in response to the Examiner's Non-final Office Action of January 19, 2010, are pending and rejected. Claim 21 has been withdrawn from consideration.

IV. Status of Amendments

No amendments were entered after final rejection. Applicant's amendment on April 6, 2010 was entered and rejected by the Examiner in the Office Action mailed July 7, 2010. Section VIII recites the claims under final rejection.

V. Summary Of Claimed Subject Matter

Independent claim 1 recites a suspension apparatus for supporting medical appliances, said suspension apparatus comprising a length of material joined together so as to form an upper section and a lower section, wherein said length of material forming said upper section and said lower section is uniform in diameter throughout said upper section and said lower section, and wherein said upper section is dimensioned to fit over a user's head, and wherein the medical appliance is attached to said lower section (taught at P9/L15-23; P10/L6-10; P10/L13-20; P11/L5-9; P11/L16-21; P12/L1-3; P12/L5-10; FIG. 1; FIG. 2; FIG. 3).

Dependent claim 7, which depends on claim 3, which depends on claim 2, which depends on claim 1, contains the additional elements of: said suspension apparatus further comprising a first end and a second end joined together into a joint thereby forming a continuous loop, wherein said joint comprises a splice, and wherein said splice has a diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter (taught at P9/L18-21; P10/L6-9; P10/L13-16; P12/1-3; FIG. 1; FIG. 2).

Independent claim 14 recites a method of retaining objects about a person comprising the steps of (A) obtaining at least one length of material having a first end and a second end (taught at P9/L15-23; P10/L6-10; FIG. 1); (B) splicing said first end to said second end of said at least one length of material (taught at P9/L18-20; P10/L14-16; P12/L1-3; FIG. 1); (C) forming said at least one length of material into an upper loop and a lower section, wherein said length of material forming said upper loop and said lower section is uniform in diameter throughout said upper loop and said lower section (taught at P9/L18-20; P10/L13-20; P12/L1-3; FIG. 1); (D) placing said at least one length of material around a person's neck (taught at P11/L7-12; P13/L13-16; FIG. 1; FIG. 2); and (E) attaching an object to said lower section (taught at P11/L5-7; P11/L16-21; P12/L5-10; FIG. 2; FIG. 3).

Independent claim 22 recites a suspension apparatus for supporting medical appliances, said suspension apparatus comprising a length of material joined together forming a spliced loop, said spliced loop further comprising at least two segments of said length of material, wherein said at least two segments are uniform in diameter, and wherein said at least two segments lie proximate and parallel one another, wherein said length of material has first end and second end, and wherein medical appliances are attached to said first end

and said second end via at least one fastener (taught at P9/L15-23; P10/L6-10; P10/L13-23; P11/L16-21; P12/L1-3; P12/L5-10; FIG. 1; FIG. 2; FIG. 3).

VI. Grounds of Rejection To Be Reviewed On Appeal

1. Rejection of claims 1, 14, and 22 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

2. Rejection of claims 1-19 under 35 U.S.C. §103(a) over Giacona, III (U.S. Pat. Publ. No. 2005/0092789) in view of Chu et al. (U.S. Pat. Publ. No. 2004/0225181).

3. Rejection of claims 20 and 22 under 35 U.S.C. §103(a) over Giacona, III '789, in view of Chu '181, further in view of Millen (U.S. Pat. No. 6,129,709).

VII. Argument

On September 30, 2003, Applicant filed Patent Application No. 10/674,758. On June 26, 2009, the Examiner issued a requirement for Restriction/Election, and Applicant responded to the requirement on July 21, 2009. In response to the Non-final Office Action issued January 19, 2010 the Applicant amended the claims on April 6, 2010. The Examiner issued a Final Office Action on July 7, 2010 and this Appeal followed.

A. The claims and specification clearly convey that Applicant had possession of the invention at the time the application was filed.

In the Office Action mailed July 7, 2010, the Examiner rejected claims 1, 14 and 22 under 35 U.S.C. § 112, first paragraph, because they “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 14, and 22 have been amended to indicate an upper and lower section which is uniform in diameter.”¹ Claim 1 recites an “upper section” and a “lower section” that are “uniform in diameter,” claim 14 recites an “upper loop” and a “lower section” that are “uniform in diameter,” and claim 22 recites “at least two segments ... wherein said at least two segments are uniform in diameter.”

On page 9, lines 18-20, the Specification recites that “the invention is preferably a soft flexible length of material ... spliced so as to complete the circle in a fashion that does not increase the diameter of the spliced area.” On page 10, lines 14-16, the Specification recites that “preferably, splice **30** is smooth and has substantially the same diameter **32** as the diameter **26** of length of material **20**.” These disclosures in the Specification clearly convey that, at the time of filing the instant patent application, Applicant was aware of the

¹ Office Action, page 2, mailed July 7, 2010.

potential importance of the *entire* invention having a uniform diameter, and so described her invention. Because Applicant addressed, and proposed a solution to, the problem of having a *non-uniform* diameter, anyone skilled in the art would clearly recognize that Applicant had possession of the invention with an upper and lower section having uniform diameters.

Further, length of material **20** has a diameter **26**, and length of material **20** is preferably formed into a shape that it creates upper loop **40**, bottom **60**, and lower doubled section **50**.² Therefore, upper loop **40**, bottom **60**, and lower doubled section **50** inherently must have the same, and thus a uniform diameter **26**. Additionally, claim 7, which indirectly depends on claim 1 and was filed with the original patent application on September 30, 2003, recites “said splice has a diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter.” Disclosure in an originally filed claim can satisfy the written description requirement³, and claim 7 implicitly recites the length of material having a *single, uniform diameter*, which is thus applicable to the upper section and the lower section.

² Specification, page 10, lines 18-20.

³ *Union Oil Co. of Calif. v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000) (citing *In re Gardner*, 480 F.2d 879, 880 (C.C.P.A. 1973)).

However, in spite of the above support for the element in claims 1, 14 and 22, the Examiner has maintained the rejection of claims 1, 14 and 22 under § 112 seemingly because the exact phrase “uniform diameter” was not included in the specification. However, “there is no need for a verbatim description of every claimed embodiment.” *In re Hunter*, 1995 U.S. App. LEXIS 15363, 15380 (Fed. Cir. 1995) (citing *In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978)). Instead, 35 U.S.C. § 112 requires “that the patent specification set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 928 (Fed. Cir. 2004).

Applicant has clearly demonstrated that Applicant had possession of an embodiment of the invention in which the upper section and lower section have a uniform diameter. First, Applicant addressed, and proposed a solution to, the problem of the splice having a diameter inconsistent with the length of material. Second, the Specification describes the length of material having a diameter, and the length of material comprising the upper section and the lower section, so therefore the upper section and lower section inherently each must have the same aforementioned diameter as the diameter of the length of material. Third, claim 7, which was filed with the original patent application, describes the

length of material having a diameter and the splice having a diameter “approximately equal to said length of material diameter,” and thus, implicitly, the length of material diameter is a *single, uniform* diameter.

Accordingly, for the above reasons, the Examiner’s rejection of claims 1, 14 and 22 under 35 U.S.C. § 112, paragraph 1, should be overturned.

B. 35 U.S.C. §103(a) Rejections

“It is well settled that the PTO ‘bears the initial burden of presenting a prima facie case of unpatentability.’”⁴ Because all of the elements in the claims are not disclosed in the cited references, the Examiner has not met this burden.

1. Chu ‘181 does not qualify as a reference

Chu ‘181 has a filing date of April 26, 2004, and it claims priority to Provisional Application No. 60/465,722, filed April 25, 2003. Applicant filed the instant patent application September 30, 2003. Because Chu ‘181 does not qualify as a reference under 35 U.S.C. § 102 it cannot be used to support a § 103 rejection.

Chu ‘181 was not patented or described in a printed publication before the invention thereof by Applicant⁵. Chu ‘181 was not patented or described in

⁴ *In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007), citing *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002)).

a printed publication more than one year prior to the date of the application⁶. Chu '181 similarly does not qualify under 35 U.S.C. §§ 102(c)-(d). 35 U.S.C. § 102(e) requires that “the invention was described in (1) **an application for patent, published under section 122(b)**, by another *filed* in the United States before the invention by the applicant for patent.”⁷ Chu '181, i.e., U.S. Patent Application No. 10/823,653 and U.S. Publ. No. 2004/0225181, was filed on April 26, 2004, which was after Applicant's patent application. It is important to note that § 102(e) does not reference the *effective filing date*, but instead references the *date filed*. Therefore, Chu '181 does not qualify as a reference under 35 U.S.C. § 102(e), because the provisional patent application on which Chu '181 is based, which was filed April 25, 2003, also does not qualify as a reference under 35 U.S.C. § 102(e) because of the specific requirement that the reference be an application for patent, published under section 122(b). Finally, the Examiner has offered no evidence to support the Examiner's presumed contention that the provisional application from which Chu '181 is based for priority contains the same matter as is found in Chu '181.⁸ Therefore, for at

⁵ 35 U.S.C. § 102(a).

⁶ 35 U.S.C. § 102(b).

⁷ 35 U.S.C. § 102(e) (emphasis added).

⁸ *In re Wertheim*, 646 F.2d 527 (CCPA 1981), citing *In re Lund*, 376 F.2d 982 (CCPA 1967)(a patent is only “entitled to the filing date of the parent

least the aforementioned reasons, neither Chu '181 nor the provisional application filed April 25, 2003 qualify as a reference.

2. Applicant invented before the earliest filing date on which Chu '181 can rely.

Applicant has submitted an Declaration herewith attesting to the fact that Applicant conceived of the invention in the instant patent application on December 17, 2002. In addition, the undersigned has Applicant's Affidavit also attests to the fact that Applicant was diligent in reducing the invention to practice, interviewing patent attorneys, and obtaining funds to proceed with protecting Applicant's invention. Because Chu '181, *at the earliest*, has a filing date of April 25, 2003, Chu '181 is not a reference and therefore cannot be used to sustain a rejection under 35 U.S.C. § 103.

3. Assuming, arguendo, that Chu '181 would have qualified as a reference, Chu '181 does not recite all the limitations in independent claims 1, 14 and 22

a. Chu teaches a uniform thickness, not a uniform diameter

In the Final Office Action, mailed July 7, 2010, the Examiner referred to Chu et al. '181 to supply the element of upper and lower sections that are uniform in diameter. However, as the Examiner conceded in the Advisory

application as to all subject matter carried over into it from the parent application ... as evidence to defeat another's right to patent.”)

Action mailed February 2, 2011, Chu et al. '181 merely teaches a sling that may have a uniform *thickness*.

In essence, the Examiner is arguing that the word “thickness” is subsumed by the word “diameter”. Not only is this argument counter-intuitive, it is contrary to established rules regarding claim construction. Claim terms should be interpreted as a person having ordinary skill in the art would interpret them.⁹ Thickness is NOT diameter, and a person having ordinary skill in the art would not interpret such to be so. Accordingly, Chu et al. '181 does not supply the missing requirement of a “uniform diameter” as required by Applicant’s independent claims 1, 14 and 22 and the rejection as to claims 1, 14 and 22, and all claims depending therefrom, should be overturned.

b. Chu et al. '181 does not teach an upper and lower section that are “uniform in diameter”

Claim 1 recites an “upper section” and a “lower section” that are “uniform in diameter,” claim 14 recites an “upper loop” and a “lower section” that are “uniform in diameter,” and claim 22 recites “at least two segments ... wherein said at least two segments are uniform in diameter.” In the Final Office Action of July 7, 2010, the Examiner claims that “Chu teaches a support apparatus comprising upper and lower sections wherein the material is uniform

⁹ *Festo Corp., v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 123 S.Ct. 70 (2002).

in diameter (FIG. 3, item 16, paragraph [0035]).” However, instead of teaching an “upper section” and a “lower section” having a uniform diameter, Chu ‘181 teaches a “sling **16** [that] may have a uniform *thickness* over the entire length and/or width of sling **16**.”¹⁰

The Examiner cannot pull out of the air a structure and function where there is none taught¹¹. The sling **16** in Chu ‘181 is a single component that, as far as Applicant can determine, does not comprise any subcomponents. Therefore, Chu ‘181 does not teach “a length of material joined together so as to form an upper section and a lower section, wherein said length of material forming said upper section and said lower section is uniform in diameter throughout said upper section and said lower section,” and Applicant respectfully submits that the Examiner has not established a *prima facie* case of unpatentability, and therefore the Examiner’s rejection of claim 1 should be overturned.

The Examiner similarly relies on Chu ‘181 to teach claim 14 that recites “forming at least one length of material into an upper loop and a lower section, wherein said length of material forming said upper loop and said lower section

¹⁰ Chu et al. ‘181, paragraph [0035].

¹¹ In *Ex parte Yoshida*, the Board found “that the Examiner is speculating and extrapolating from beyond the disclosure.” *Ex parte Yoshida*, 2002 Pat. App. LEXIS 215, 216-219 (Pat. App. 2002).

is uniform in diameter throughout said upper loop and said lower section,” so therefore the Examiner’s rejection of claim 14 should also be overturned. Finally, because the Examiner again similarly relies on Chu ‘181 to teach the element in claim 22 that recites “said spliced loop further comprising at least two segments of said length of material, wherein said at least two segments are uniform in diameter,” the Examiner’s rejection of claim 22 should also be overturned.

4. Dependent claim 7

Claim 7, which depends from claim 3, recites “wherein said splice has a diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter.” In the Final Office Action mailed July 7, 2010, the Examiner relies on FIG. 1 in Chu ‘181 to teach this element.

However, as the Examiner stated *in the same Final Office Action*, “figures may not be used to show support for limitations relating to scale/relative size of elements (MPEP 2125).”¹² An examination of FIG. 1 in Giacona, III ‘181 reveals that, contrary to stitching 15 and stitching 30 appearing to be the same diameter as the diameter of the materials being

¹² Office Action, page 2, mailed July 7, 2010.

secured to each other, stitching **15** and **30** appear to be noticeably larger than cable **27**. Furthermore, Giacona, III ‘181 teaches that the “cable **27** [which is being attached to strap **11**] is *preferably a much smaller diameter* than the maximum thickness of large loop member **11**.”¹³ Contrary to teaching “said splice diameter [being] approximately equal to said length of material diameter,” as is required to sustain the Examiner’s § 103(a) rejection, if Giacona, III ‘181 teaches anything on this subject it teaches a splice diameter that is necessarily different than the diameter of the materials.

C. Conclusion

In light of the aforementioned arguments, the Examiner has clearly erred with respect to the patentability of the claimed invention. It is respectfully requested that the Board overturn the Examiner’s rejection of all pending claims and hold that the claims satisfy the requirements of 35 U.S.C. §§ 103, 112.

{Signature Follows on Next Page}

¹³ Chu et al. ‘181, paragraph [0109] (Emphasis added).

Respectfully submitted, this 7th day of March, 2011,

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VIII. Claims Appendix

1. (Previously presented) A suspension apparatus for supporting medical appliances, said suspension apparatus comprising a length of material joined together so as to form an upper section and a lower section, wherein said length of material forming said upper section and said lower section is uniform in diameter throughout said upper section and said lower section, and wherein said upper section is dimensioned to fit over a user's head, and wherein the medical appliance is attached to said lower section.

2. (Original) The suspension apparatus of claim 1, further comprising a first end and a second end joined together into a joint thereby forming a continuous loop.

3. (Original) The suspension apparatus of claim 2, wherein said joint comprises a splice.

4. (Original) The suspension apparatus of claim 3, wherein said splice is smooth.

5. (Original) The suspension apparatus of claim 1, wherein said length of material is formed from nylon.

6. (Original) The suspension apparatus of claim 1, wherein said length of material comprises a chain of linked elements.

7. (Original) The suspension apparatus of claim 3, wherein said splice has a diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter.

8. (Original) The suspension apparatus of claim 2, wherein said continuous loop comprises a top section and a bottom section.

9. (Original) The suspension apparatus of claim 8, wherein said bottom section comprises at least two segments of said length of material gathered together.

10. (Original) The suspension apparatus of claim 9, wherein said at least two segments lie proximate one another.

11. (Original) The suspension apparatus of claim 10, wherein said at least two segments are parallel to one another.

12. (Original) The suspension apparatus of claim 9, further comprising means for securing said at least two segments together.

13. (Original) The suspension apparatus of claim 12, wherein said means for securing comprises at least one clasp.

14. (Previously presented) A method of retaining objects about a person comprising the steps of:

a) obtaining at least one length of material having a first end and a second end;

b) splicing said first end to said second end of said at least one length of material;

c) forming said at least one length of material into an upper loop and a lower section, wherein said length of material forming said upper loop and said lower section is uniform in diameter throughout said upper loop and said lower section;

d) placing said at least one length of material around a person's neck;
and

e) attaching an object to said lower section.

15. (Original) The method of claim 14, wherein said lower section comprises at least two segments of said at least one length of material.

16. (Original) The method of claim 15, wherein said at least two segments lie proximate one another.

17. (Original) The method of claim 14, wherein said lower portion comprises two parallel segments.

18. (Original) The method of claim 16, further comprising the step of:

c') installing means for gathering on said lower section of said at least one length of material,

19. (Original) The method of claim 18, wherein said means for gathering comprises clasps.

20. (Original) The method of claim 14, wherein said step of attaching comprises pinning the object to said lower portion via at least one safety pin.

21. (Withdrawn-Previously presented) A medical appliance comprising:

at least one wound drainage system; and

at least one support for said at least one wound drainage system, wherein said support comprises a length of material forming a spliced loop, wherein said spliced loop comprises a top section, a bottom section and at least one fastener, and wherein said top section and said bottom section are uniform in diameter, and wherein said bottom section further comprising at least two segments of said length of material, wherein said at least two segments lie proximate and

parallel one another, and wherein said two segments are held together via said at least one fastener.

22. (Previously presented) A suspension apparatus for supporting medical appliances, said suspension apparatus comprising a length of material joined together forming a spliced loop, said spliced loop further comprising at least two segments of said length of material, wherein said at least two segments are uniform in diameter, and wherein said at least two segments lie proximate and parallel one another, wherein said length of material has first end and second end, and wherein medical appliances are attached to said first end and said second end via at least one fastener.

IX. Evidence Appendix

Declaration of Pamela K. Hardison.

Declaration of Thomas R. Williamson III

X. Related Proceedings Appendix

None.